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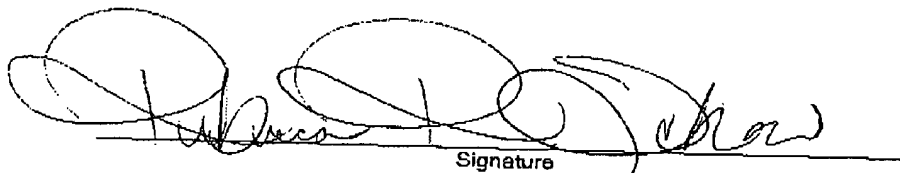
Application No.: 09/826,198

Attorney Docket No.: 40000-0011 (50P4377)

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MAY 15 2006

Serial No.: 09/826,198

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application: David H. Bessel

Application No.: 09/826,198

Filed: April 4, 2001

Title: "Method and Apparatus for Legacy Analog
Video Interconnections in a Set-Top Box
for Personal Video Recording Applications"

Examiner: LAMBRECHT, Christopher M.

Group Art Unit: 2623

Confirmation No.: 2595

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on November 24, 2005 and in response to the Notice of Panel Decision for Pre-Appeal Brief Review mailed on April 18, 2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) **\$500.00**.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provision of 37 CFR 1.136 (a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: CFR 1.17(a)-(d)) for the total number of months checked below:

() one month \$120.00
() two months \$450.00
() three months \$1020.00
() four months \$1590.00

() The extension fee has already been filed in this application

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant had inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 18-0013/40000-0011 the sum of **\$500.00**. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 18-0013 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 18-0013 under CFR 1.16 through 1.21 inclusive, and any other section in the Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

(X) I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (571) 273-8300 on May 15, 2006.

Number of pages: 19

Signature: 

Rebecca R. Schow

Respectfully submitted,

By: 

Steven L. Nichols (Reg. No.: 40,326)
Attorney/Agent for Applicant(s)
Telephone No.: (801) 572-8066
Date: May 15, 2006

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Patent Application of

David H. Bessel

Application No. 09/826,198

Filed: April 4, 2001

For: Method and Apparatus for Legacy
Analog Video Interconnections in a
Set-Top Box for Personal Video
Recording Applications

Group Art Unit: 2623

Examiner: Lambrecht, Christopher M.

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an Appeal Brief under Rule 41.37 appealing the final decision of the Primary Examiner dated October 5, 2005. Each of the topics required by Rule 41.37 is presented herewith and is labeled appropriately.

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I. Real Party in Interest

The present application has been assigned to, and the real parties in interest are, Sony Corporation of Tokyo, Japan and Sony Electronics, Inc. of New Jersey, U.S.A. (See assignment recorded at Reel/Frame 011685/0847).

II. Related Appeals and Interferences

There are no appeals or interferences related to the present application of which the Appellants are aware.

III. Status of Claims

Claims 1-27 are currently pending in the application and all stand finally rejected. Appellant appeals from the final rejection of claims 1-27, which claims are presented in the Appendix.

IV. Status of Amendments

Following the final Office Action of October 5, 2005, Appellant filed one after-final response on January 19, 2006. However, that response did not propose any amendments to the application. Consequently, its entry into the record has no effect on the content of the claims presented in the Appendix.

V. Summary of Claimed Subject Matter

As shown in Fig. 2, a television signal (108) is received by the system. This signal (108) may be an analog signal, a digital signal or a composite signal carrying both legacy analog signals as well as digital signals. The signal (108) may also be carrying multiple

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channels of television programming. In order to fully handle the signal (108), irrespective of its components, the signal (108) is provided to two tuners, an analog tuner (101) and a digital tuner (102). (Appellant's specification, paragraph 0041). The analog tuner (101) can tune an analog signal at a particular frequency. Similarly, the digital tuner (102) separates out the digital signal for a particular digital channel or program from among the many channels that may be carried by the composite signal (108). (Appellant's specification, paragraph 0042).

In the analog signal path, the analog signal output by the tuner (101) is first converted into a digital signal by a video decoder (109). The signal could then be output to a television set (106) which is capable of displaying digital audiovisual signals. However, to simplify the interconnections between system components, the now-digital signal is compressed with an MPEG2 encoder (105). (Appellant's specification, paragraph 0043). The compressed signal is then routed through a demultiplexer (103). From the demultiplexer (103), the compressed signal, which was originally received as an analog signal, can be recorded on a hard disk drive (107) or other digital data storage medium. Alternatively, the signal can be decompressed with an MPEG2 decoder (104) and output to a television set (106) for display. (Appellant's specification, paragraph 0044).

Digital signals output by the digital tuner (102) must be handled differently. A digital signal output by the tuner (102) is routed into the same demultiplexer (103) that handles signals from the analog tuner (101) that have been converted to digital and compressed. (Appellant's specification, paragraph 0045). After demultiplexing, the digital signal, which was compressed before broadcasting, can be sent to and recorded on a hard disk drive (107) or other digital recording medium. Alternatively, the signal can be decompressed by an MPEG2 decoder (104). The decompressed digital signal can then be sent to a television set (106) for display. (Appellant's specification, paragraph 0046).

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This arrangement requires only a single connection between the system and the television set (106). Additionally, the system requires only a single connection between the system and a PVR, hard disk drive (107) or other digital recording medium. Consequently, the system of the present invention is much simpler as to the interconnections required than conventional systems with equivalent functionality. (Appellant's specification, paragraph 0047).

VI. Grounds of Rejection to be Reviewed on Appeal

In the final Office Action, the following rejections were made. Thus, Appellant requests review on this appeal of the following grounds of rejection.

Claims 1, 5-8, 10, 12, 13, 15, 16, 18-20, 22-27 were rejected as anticipated under 35 U.S.C. § 102(e) by U.S. Patent Application Publication 20040261112 to Hicks et al. ("Hicks").

Claims 2-4 and 14 were rejected under 35 U.S.C. § 103(a) in view of Hicks taken alone.

Claims 9 and 11 were rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Hicks and U.S. Patent No. 6,483,986 to Krapf.

Claims 17 and 21 were rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Hicks and U.S. Patent No. 6,788,882 to Greer et al.

VII. Argument

All of the rejections made in the final Office Action rely, in whole or in part, on the Hicks reference. However, Appellant has made of record evidence which demonstrates that the invention claimed in the present application was made prior to the filing date of the Hicks

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reference. Thus, a principal issue on this appeal is whether Appellant has successfully antedated the applied prior art reference to Hicks under 37 C.F.R. § 1.131.

Appellant has filed several declarations under 37 C.F.R. § 1.131 and 1.132 to make of record those facts that show complete invention prior to the filing date Hicks. However, in the Advisory Action of February 8, 2006, the Examiner held the previous declarations to be ineffective under 37 C.F.R. § 1.131 as not evidencing a reduction to practice. Appellant respectfully disagrees.

ACTUAL REDUCTION TO PRACTICE:

"Reduction to practice" means that the invention has been taken beyond a mere conception and is rendered in sufficient detail that one of skill in the art may make and use the invention without undue experimentation. This is why an enabling disclosure under 35 U.S.C. § 112, filed as a patent application, can serve as a "constructive" reduction to practice.

An actual reduction to practice can clearly be demonstrated by producing a working prototype. However, the patent law also recognizes that some inventions can be described clearly enough on paper, as in a blue print, the one of skill in the art is then able to make and use that invention. Consequently, the construction of the invention on paper brings the invention beyond a mere conception and constitutes a reduction of the invention to practice. (See MPEP 715.07(III) citing *In re Asahi/America Inc.*, 68 F.3d 442, 37 USPQ2d 1204, 1206 (Fed. Cir. 1995) (Citing *Newkirk v. Lulejian*, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931) (These cases hold that such evidence as pictures of the invention, coupled with a technical report describing the invention are sufficient to show reduction to practice).

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In the instant case, the Appellant has made of record a document dated September 22, 2000 ("Disclosure Document"). See Declaration under 37 C.F.R. § 1.131 filed January 19, 2006. This document contains both figures illustrating the invention as well as a written technical description. It is clearly evident from this document that one of skill in the art could have, with the document, been enabled to make and use the invention without undue experimentation. Consequently, this document represents an actual reduction to practice of the invention claimed in this application prior to the filing of the Hicks reference.

Specifically, claim 1 of the instant application presently recites:

A television signal processing and recording system for handling both digital and analog video signals, said system comprising:
a video decoder in an analog signal path for converting an analog signal to a digital signal;
an encoder for compressing said digital signal output by said video decoder;
and
a connection for routing said compressed digital signal into a digital signal path in which said compressed digital signal is selectively either decompressed with a decoder and output to a television set or recorded on a digital data storage device.

This subject matter is disclosed and described in the Disclosure Document of September 22, 2000 in sufficient detail so as to enable practice of the invention as here claimed. Specifically, referring to Figure 2 of the Disclosure Document an analog signal path ("Analog Video") is shown that incorporates a video decoder ("Video Decoder") for converting an analog signal ("Analog Video") into a digital signal. An encoder ("MPEG2 Encoder") is also illustrated for compressing the digital signal output by the video decoder ("Video Decoder"). Figure 2 also shows a connection for routing the compressed digital signal into a digital signal path ("Digital Video," "DeMuxx") where the compressed digital signal is selectively decompressed with a decoder ("MPEG2 Decoder") or output to a digital data storage device ("PVR Hard Disk Drive"). This subject matter is further described and

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enabled to one of skill in the art in the text accompanying and describing Figure 2 of the Disclosure Document.

As further evidence that this Disclosure Document represents an effective reduction to practice, the Disclosure Document was used almost exclusively by the undersigned to prepared the instant patent application which has been held to be an enabling disclosure of the invention. The figures of the Disclosure Document dated September 22, 2000 clearly form the basis for the figures of the instant patent application.

Consequently, Appellant had both conceived of and produced an enabling written reduction to practice of the invention at least as early as September 22, 2000. For these reasons, Appellant's declarations under 37 C.F.R. § 1.131 should be held effective and the Hicks reference removed from consideration as prior art against the instant patent application.

Constructive Reduction to Practice:

In the alternative, conception of the invention occurred prior to the filing of the Hicks reference followed by diligent activity in pursuit of the invention from the date of conception to the filing of the instant patent application, which is a constructive reduction to practice. The Advisory Action of February 8, 2006 holds that the Disclosure Document of September 22, 2000 evidences conception of the invention. The instant patent application, which undisputedly represents a *constructive* reduction to practice, was filed April 4, 2001. Between September 22, 2000 and April 4, 2001, the Appellant worked diligently toward the filing of the instant application, i.e., the constructive reduction to practice.

The Applicant was an employee of Sony Electronics, Inc. ("Sony") at the time the invention was made. Consequently, consistent with applicable employment agreements, the Applicant prepared the Disclosure Document of September 22, 2000 and submitted it to the

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intellectual property department of Sony as evidenced by the "received" stamps on the Disclosure Document of September 22, 2000 which was submitted with the Declaration of January 19, 2006.

The Disclosure Document was then reviewed in October 2000 along with the many other disclosures generated by inventors at Sony. This prompt review of the disclosure evidenced its value, and the decision was made to pursue the filing of a patent application. Accordingly, a prior art search was requested on November 9, 2000 from the firm of Mooreland and Moore, Inc. in Arlington, Virginia. The results of this search were received December 8, 2000 along with a statement that "no references were found to disclose the immediate objects of the instant invention."

Appellant and Sony then conducted a review the results of the search report. Following this review, the decision was made to proceed with the present patent application. On January 24, 2001, the Disclosure Document of September 22, 2000 was provided by Sony to the undersigned with instructions to prepare the instant patent application. The undersigned has declared on the record under 37 C.F.R. § 1.132 that the application was then diligently prepared consistent with the demands of other client projects. The instant application was then filed a little over two months later on April 4, 2001.

These facts, made of record by the undersigned under 37 C.F.R. § 1.132, illustrate conception of the invention prior to the filing of the Hicks reference and diligent activity in pursuit of the invention from the date of conception to the filing of the instant patent application, which is a constructive reduction to practice. For these alternative reasons, the Hicks reference should be removed from consideration as prior art against the present application.

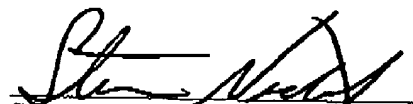
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In view of the foregoing, it is submitted that the final rejection of the pending claims is improper and should not be sustained. Therefore, a reversal of the Final Rejection of October 5, 2005 is respectfully requested.

Respectfully submitted,

DATE: May 15, 2006


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Registration No. 40,326

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CERTIFICATE OF TRANSMISSION

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Rebecca R. Schow

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VIII. CLAIMS APPENDIX

1. (previously presented) A television signal processing and recording system for handling both digital and analog video signals, said system comprising:
 - a video decoder in an analog signal path for converting an analog signal to a digital signal;
 - an encoder for compressing said digital signal output by said video decoder; and
 - a connection for routing said compressed digital signal into a digital signal path in which said compressed digital signal is selectively either decompressed with a decoder and output to a television set or recorded on a digital data storage device.
2. (previously presented) The system of claim 1, further comprising a demultiplexer in said digital signal path for receiving and demultiplexing said compressed digital signal when said compressed digital signal is routed to said digital signal path or a digital signal received in digital format and not sent through said video decoder.
3. (original) The system of claim 2, further comprising a digital tuner for outputting a tuned digital signal into said digital signal path.
4. (original) The system of claim 3, wherein said digital tuner outputs said digital signal to said multiplexer.
5. (original) The system of claim 1, wherein said digital data storage device is a hard disk drive.

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6. (original) The system of claim 1, further comprising an analog tuner for outputting said analog signal to said video decoder.
7. (original) The system of claim 1, wherein said encoder is an MPEG2 encoder.
8. (original) The system of claim 1, wherein said decoder is an MPEG2 decoder.
9. (previously presented) The system of claim 1, wherein said video decoder, encoder, connection and decoder are incorporated in a set-top box.
10. (original) The system of claim 1, wherein said digital data storage device is incorporated in a personal video recorder.
11. (previously presented) The system of claim 1, wherein said video decoder, encoder, connection, decoder and digital data storage device are incorporated in a single set-top unit.
12. (original) A method of processing and recording a television signal that handles both digital and analog video signals, said method comprising:
converting an analog signal to a digital signal; and

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compressing and decompressing said digital signal before outputting said digital signal to a television set.

13. (original) The method of claim 12, further comprising, after converting said analog signal to said digital signal and after compressing said digital signal, routing said compressed digital signal from an analog signal path to a digital signal path in which said compressed digital signal is decompressed and output to a television set.

14. (original) The method of claim 13, further comprising demultiplexing said compressed digital signal when said compressed digital signal is routed to said digital signal path.

15. (original) The method of claim 13, further comprising tuning a digital signal with a digital tuner and outputting said tuned digital signal into said digital signal path.

16. (original) The method of claim 12, further comprising, after converting said analog signal to said digital signal and after compressing said digital signal, recording said compressed digital signal on a digital data recording device.

17. (original) The method of claim 16, wherein said converting and compressing said digital signal are performed with a set-top box and said recording is performed by a personal video recorder.

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18. (original) A system for processing and recording a television signal that handles both digital and analog video signals, said system comprising:

means for converting an analog signal to a digital signal;

means for compressing and decompressing said digital signal.

19. (original) The system of claim 18, further comprising means for outputting said digital signal to a television set.

20. (original) The system of claim 18, further comprising means for recording said digital signal when said digital signal is compressed.

21. (original) The method of claim 20, wherein said means for converting and for compressing and decompressing said digital signal are housed in a set-top box and said means for recording are housed in a personal video recorder.

22. (previously presented) A television signal processing and recording system for handling both digital and analog video signals, said system comprising:

a video decoder in an analog signal path for converting an analog signal to a digital signal;

an encoder for compressing said digital signal output by said video decoder; and

a decoder for decompressing said digital signal compressed by said encoder.

23. (original) The system of claim 22, further comprising a connection for outputting said digital signal to a television set when said digital signal is decompressed.

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24. (original) The system of claim 22, further comprising a digital data storage device for recording said digital signal when compressed by said encoder.
25. (original) The system of claim 22, further comprising a digital tuner for outputting a tuned digital signal to said decoder.
26. (original) The system of claim 22, further comprising an analog tuner for outputting a tuned analog signal to said video decoder.
27. (original) The system of 22, wherein said digital data storage device is a hard disk drive.

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IX. Evidence Appendix

None

X. Related Proceedings Appendix

None

XI. Certificate of Service

None